

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Ricky W. Purcell Art Unit 1615
Serial No. 10/645,447
Filed August 20, 2003
Confirmation No. 7982
For A SYSTEM FOR PROVIDING THERAPY TO A PORTION OF A BODY
Examiner Isis A.D. Ghali

May 23, 2008

REPLY BRIEF

Applicant is submitting this Reply Brief in response to Examiner's Answer dated March 25, 2008.

In Examiner's Answer, the Office states that Applicant's argument, specifically with regard to claim 40, that the '358 reference fails to teach or suggest a system comprising a container and a first patch, a second patch, and a flexible wrap all located within the same compartment in the container is unpersuasive. Specifically, the Office states that '358 discloses a device including packets that read on the patches as claimed by Applicant, discloses a flexible wrap as part of its device, and the device itself that reads on the container since all of the other elements are contained in the device. Accordingly, '358 discloses each and every limitation.

Applicant respectfully disagrees as (also noted in the Appeal Brief) claim 40 requires a first patch providing a first therapy, a second patch providing a second, separate therapy, and a flexible wrap adapted to secure at least one of said first patch and second patch to a portion of the user's body. The first patch, second patch, and flexible wrap are all within the same compartment of a container. As noted above, '358 fails to show a first patch, a second patch, and a flexible wrap within

the same compartment of a container. More particularly, by contrast, as noted throughout the '358 reference, the device has a **compartmentalized design**, wherein each compartment may include cooling OR heating packets.¹ More particularly, the compartmentalized design is desirable to provide flexibility and even cooling or heating to the user.² Furthermore, as noted by the Office, the flexible wrap is the device, and thus, cannot be located within a compartment of the device. Accordingly, as nowhere is it disclosed that a single compartment of the device includes at least a first packet and a second packet and a flexible wrap as required in Applicant's claim 40, claim 40 cannot be anticipated by the '358 reference.

Moreover, the Office states that present claim 40 recites the expression "comprising," and thus, '358 discloses all of the elements of the system of claim 40. Applicant is confused with the reasoning of this last statement. If the Examiner's position is that by using the expression "comprising," Applicant's claim 40 is open-ended and thus the device, containing the packets, can be used as the container to read on the instantly claimed invention, Applicant respectfully disagrees.

While "comprising" is open-ended claim language, the prior art must still disclose each and every limitation of a "comprising" claim to anticipate the claim. Specifically, as noted in MPEP 2111.03, "an open language transitional phrase, while not excluding additional, unrecited elements or method steps, requires the **named elements as essential.**" As such, the container of Applicant's claim 40, while capable of including other components, requires a first patch, a second patch, **and** a

¹ See e.g., U.S. 4,592,358 at column 1, lines 7-10; column 2, line 34; and column 3, lines 7-11 and lines 42-47.

² Id. at column 3, lines 42-47 and column 5, lines 2-5.

flexible wrap all within the same compartment of the container. Accordingly, the device of '358, which fails to disclose a first patch, a second patch, and a flexible wrap within the same compartment of the container, cannot anticipate the system as required in Applicant's claimed invention.

As Applicant's claim 40 has structural differences from that of the device in the '358 reference, claim 40 is novel over the '358 device. Furthermore, claims 41, 43, 46, and 47, which directly depend from claim 40 are novel over the '358 reference for the same reasons set forth above (and in the Appeal Brief filed December 26, 2007) for claim 40, as well as for the additional elements they require.

Moreover, with regard to the 103 rejection of claim 42 over the '358 reference in view of the '347 reference, the Office states that '347 is relied solely upon for the teaching of an analgesic patch and for teaching the combination of endothermic, exothermic, and analgesic patch in one device. Accordingly, it appears the Examiner is giving no weight to Applicant's argument that by combining the '358 and '347 references, the purpose of '347 would be defeated, and thus, claim 42 cannot be obvious in view of the combination of cited references.

Applicant respectfully notes that as stated in MPEP § 2141.02, "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."³ Furthermore,

[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full

³ MPEP § 2141.02 (emphasis in original) (citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)).

appreciation of what such references fairly suggests to one of ordinary skill in the art.⁴

Thus, reading and interpreting only a portion of a disclosure is inconsistent with MPEP rules. The '347 reference must thus be read as a whole. While it is true that '347 teaches using a therapeutic drug or analgesic patch with a temperature control apparatus, when reading the reference as a whole, one skilled in the art would understand that if the DDDS, containing a therapeutic drug (or the analgesic patch) was placed within the device of '358 so as to become heated or cooled, the drug could not reach the skin and thus the purpose of the '347 invention would be destroyed.

Furthermore, Applicant's position that the '347 reference teaches away from combining the DDDS in a compartment with a heating or cooling mechanism, such as found in the '358 reference, is further supported by the '347 reference itself in column 12, lines 7-9 in which the reference **expressly** teaches that the temperature control apparatus and the DDDS are preferably stored in separated compartments of an air tight container (or in separate air tight containers).

As neither the '358 nor the '347 reference teaches each and every limitation of Applicant's claim 40, and further, there is no reason provided by the Office to predictability modify and/or combine the references, claim 42 is patentable over the cited references.

⁴ Chisum § 5.03[3][a][i][F], quoting In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)). See also *id.* At n. 42 ("It is not permissible to pick and choose only so much of any given reference as will support a given position and ignore the reference in its totality." (quoting Lubrizol Corp. v. Exxon Corp., 696 F.Supp. 302, 322, 7 USPQ2d 1513, 1527 (N.D. Ohio 1988))).

Conclusion

In addition to the reasons set forth in Applicant's Appeal Brief, the rejections of the claims on appeal are in error for the reasons set forth above. Therefore, Applicant requests that the Examiner's rejections of claims 40-43, 46, and 47 be reversed. Applicant does not believe that any fee is due in connection with this reply. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment of any fees to Deposit Account No. 01-2384.

Respectfully submitted,

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Via EFS